



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,733	03/23/2004	Michael W. Hawman	EH-10536 B	2544

52237 7590 03/22/2007
BACHMAN & LAPOINTE, P.C. (P&W)
900 CHAPEL STREET
SUITE 1201
NEW HAVEN, CT 06510-2802

EXAMINER

JARRETT, RYAN A

ART UNIT	PAPER NUMBER
----------	--------------

2125

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/806,733

Applicant(s)

HAWMAN ET AL.

Examiner

Ryan A. Jarrett

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims 17-21 drawn to an invention nonelected with traverse in papers filed 06/05/2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120.

This application is a "divisional" of 10/064,105 filed on 06/11/2002, which claims priority to United States Provisional Patent Application number 60/297,653 filed on 06/12/2001.

It is noted however that this application is a voluntary divisional application, since parent patent application No. 10/064,105 was never restricted. Thus, the provisions of 35 U.S.C. 121 do not apply in this case.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 22-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Marshall et al. US 6,728,610. Marshall et al. discloses:

22. A gas turbine engine part (e.g., col. 1 lines 9-11), comprising:

a tag comprising at least one part identifier information affixed to a gas turbine engine part having undergone a maintenance operation, wherein said tag corresponds to an electronic record and is a substitute for a plurality of paperwork pertaining to said maintenance operation (e.g., col. 1 lines 60-65: “In one embodiment, the ‘as flying’ configuration can be determined, at least in part, by querying bar codes associated with one or more engine components. Alternatively, or in combination with the use of such bar codes, the ‘as flying’ configuration can be determined by querying microchips associated with one or more engine components”, col. 3 lines 13-29: “Alternatively, or in combination, programmable devices capable of storing, receiving, and/or sending data can be associated with one or more engine components. In one embodiment, microchips can be associated with the

Art Unit: 2125

components, and can be queried by the maintenance system. For example, microchips known as 'smart tags' can be attached to or otherwise associated with the components.", EN: *The claimed "tag" is interpreted to be a microchip memory, and corresponds to the "smart tag" of Marshall et al. The claimed "part identifier information" is interpreted to be a type of data stored on the claimed "tag", or memory. Apparatus claims must be structurally distinguishable from the prior art. The type of data stored on a memory does not limit the structure of the memory.*)

23. The gas turbine engine part of claim 22, wherein said at least one part identifier information comprises a part information section, a customer information section, a status section, a bar code section and a routing information section (e.g., col. 3 lines 13-29, EN: *The claimed "sections" are interpreted to be different types of data stored on the claimed "tag", or memory. Apparatus claims must be structurally distinguishable from the prior art. The type of data stored on a memory does not limit the structure of the memory.*).

24. The gas turbine engine part of claim 23, wherein said status section comprises a disposition of said part according to said electronic record (e.g., col. 3 lines 13-29, EN: *The claimed "section" is interpreted to be a type of data stored on the claimed "tag", or memory. Apparatus claims must be structurally distinguishable from the prior art. The type of data stored on a memory does not limit the structure of the memory.*).

25. The gas turbine engine part of claim 23, wherein said bar code section comprises a unique identifier of said part assigned to said electronic record (e.g., col. 3 lines 13-29, EN: *The claimed "section" is interpreted to be a type of data stored on the claimed "tag", or memory. Apparatus claims must be structurally distinguishable from the prior art. The type of data stored on a memory does not limit the structure of the memory.*).

26. The gas turbine engine part of claim 23, wherein said routing information section comprises a maintenance operation history of said part through a maintenance facility (e.g., col. 3 lines 13-29, EN: *The claimed "section" is interpreted to be a type of data stored on the claimed "tag", or memory. Apparatus claims must be structurally distinguishable from the prior art. The type of data stored on a memory does not limit the structure of the memory.*).

27. The gas turbine engine part of claim 22, wherein said maintenance operation is a maintenance, repair or overhaul of said part (e.g., col. 3 lines 13-29, EN: *Apparatus claims must be structurally distinguishable from the prior art. The type of "operation" undergone by the claimed "gas turbine engine part" does not limit the structure of the gas turbine engine part.*).

Art Unit: 2125

5. Claim 22 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin US 4,280,185.

Martin discloses:

22. A gas turbine engine part, comprising:

a tag comprising at least one part identifier information affixed to a gas turbine engine part having undergone a maintenance operation, wherein said tag corresponds to an electronic record and is a substitute for a plurality of paperwork pertaining to said maintenance operation (e.g., col. 1 lines 7-10: "This invention relates to information recording systems, and, more particularly to a fully automated tracking system for recording the service life history and configuration of gas turbine engines.", col. 1 lines 56-65: "According to one aspect of the present invention an LTS includes a non-volatile memory, a life tracking unit (LTU), and a plurality of module identifier units mounted on associated engine modules which provide the module identification signal information to the LTU, the LTU including an electronic signal processor which periodically interrogates each of the module identifier units and stores the identification signal information received in response at permanent address locations in the non-volatile memory.", EN: *The "module identifier units" of Martin correspond to the claimed "tag".*).

27. The gas turbine engine part of claim 22, wherein said maintenance operation is a maintenance, repair or overhaul of said part (e.g., col. 3 lines 13-29, EN: *Apparatus claims must be structurally distinguishable from the prior art. The type of "operation" undergone by the claimed "gas turbine engine part" does not limit the structure of the gas turbine engine part.*).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2125

7. Claims 22-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 48-73 of copending Application No. 10/064,105.

It is noted that the instant application is a voluntary divisional application, since parent patent application No. 10/064,105 was never restricted. Thus, the provisions of 35 U.S.C. 121 do not apply in this case.

As noted above, the claims of the instant application can be interpreted to simply reduce to a gas turbine engine part having an electronic tag (i.e., microchip memory) attached thereto.

Claims 48-73 of Application No. 10/064,105 also disclose a gas turbine engine part having a tag attached thereto, said "tag" could also be interpreted to be an electronic tag, i.e., a microchip memory.

Therefore, although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are fully anticipated by the 10/064,105 application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

8. Applicant's arguments filed 12/14/2006 have been fully considered but they are not persuasive.

Applicant has not distinguished the claimed "tag" from either the "smart tag" of Marshall et al. or the "module identifier unit" of Martin.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2125

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ryan A. Jarrett
Examiner
Art Unit 2125



03/09/2007